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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Filepp et al. Group Art Unit : 2757
Serial No. : 08/933,488 Examiner : Moustafa M. Meky
Filed : September 18, 1997
For : INTERACTIVE COMPUTER NETWORK AND METHOD OF OPERATION

RECEIVED

GCT-9-300

REPLY TO OFFICE ACTION

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated September 10, 1999 in the above-identified patent application. In the Office Action, the Examiner required that Applicants copy a claim from U.S. Patent No. 5,574,864 of Charles E. Hill for purposes of an interference, since “[f]ailure to do so will be considered a concession that the subject matter of this claim is the prior invention of another under 35 U.S.C. 102(g), and thus also prior art under 35 U.S.C. 103(a)”.

Applicants respectfully decline to copy the claim that the Examiner “requires” applicants to copy because it is not directed to the same subject matter as the claims in the present application which were filed to provoke an interference with an application of Charles E. Hill that Applicants had reason to believe was pending. The feature of detecting pirated copies of a serialized software program, as claimed in U.S. Patent No. 5,574,864, is nowhere found in Applicants’ pending claims 33-38. Thus, neither the subject matter of U.S. Patent No. 5,574,864 nor the failure to copy a claim of that patent has any effect on the prosecution of pending claims 33-38 of the present application.

It is the understanding of the undersigned attorney for Applicants that the Examiner has reviewed all pending cases claiming priority from Hill's application Serial No. 07/866,867, the parent of the Hill application thought to be pending, and that none of these cases include claims similar to Applicants' presently-pending claims 33-38. Applicants call the attention of the Examiner to abandoned Hill application Serial No. 08/463,003 which claimed priority from Serial No. 07/866,867, and contained claims almost identical to Applicants' claims 33-38 (they were identical to Applicants' claims 33-38 prior to being amended during prosecution of Serial No. 08/463,003).

The pertinent claims in application Serial No. 08/463,003, claims 66-71, were abandoned after being rejected under 35 U.S.C. § 103. Independent claim 66 was rejected under § 103 as being unpatentable over Kirouac U.S. Patent No. 5,155,847 and dependent claims 67-71 were rejected as being unpatentable over Kirouac in view of Geoffrey UK publication No. 2,105,075. While the Kirouac reference is prior art (under 35 U.S.C. §102(e)) to Hill's abandoned claims 66-71, the Kirouac reference is not prior art (under 35 U.S.C. §102(e)) to Applicants' pending claims 33-38. Applicants' earliest priority date (July 15, 1988) is more than two weeks earlier than Kirouac's filing date (August 3, 1988) and Kirouac does not claim any earlier priority date(s). Applicants' pending claims 33-38 are allowable to Applicants over the prior art of record in Serial No. 08/463,003 as well as that cited herein.

Applicants have shown how claims 33-38 are supported by the specification in their Preliminary Amendment dated September 18, 1997 .

A copy of the disclosure contained on page 88 of Applicants' priority application Serial No. 08/158,026, which was inadvertently deleted from the copy of the priority application submitted to the Patent Office, is attached. A copy of page 88 of Applicants' priority application

as originally filed in the Patent Office has not been located. The copy of page 88 of the priority application submitted herewith was pulled from a computer back-up disk which had pagination and line numbering different from the originally-filed priority application. However, the substance is identical.

Reconsideration and allowance of pending claims 33-38 is thus respectfully requested.

Respectfully submitted,

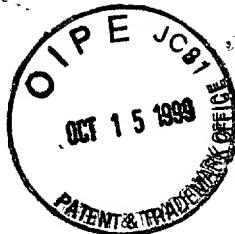
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9p/2757

PATENT

Docket No. 1963-4728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Filepp et al.

SERIAL NO.: 08/933,488

GROUP ART UNIT: 2757

FILED: September 18, 1997

EXAMINER: Moustafa M. Meky

FOR: **INTERACTIVE COMPUTER NETWORK AND METHOD OF OPERATION**

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

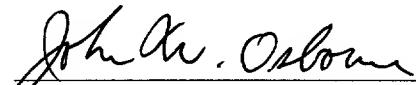
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

I hereby certify that the attached Reply To Office Action; Copy of page 88 of Applicants' priority application; and Return Receipt Postcard, along with any paper(s) referred to as being attached or enclosed and this Certificate of Mailing are being deposited with the United States Postal Service on date shown below with sufficient postage as first-class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.


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